



THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

John D. Hottovy et al.

Serial No.: 10/660,990

Filed: September 13, 2003

For: Loop Reactor Apparatus and
Polymerization Processes with Multiple
Feed Points for Olefins and Catalysts

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Group Art Unit: 1713

Examiner: Lu, C. Caixia

Atty. Docket: 210318US01
CPCM:0023/FLE

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May 22, 2006

Date

Michael G. Fletcher

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In light of the following remarks, Appellants respectfully request review of the Final Rejection in the above-identified application. This Request is being filed with a Notice of Appeal. No amendments are being filed with this Request. Appellants emphasize that the posture of the current application is troubling for many reasons. At the very least, the finality of the current prosecution is inappropriate and should be withdrawn.

In the Final Office Action, as discussed below, the Examiner: (1) improperly posed both a rejection under double patenting and a rejection under 35 U.S.C. § 102(b) *based on the same reference*; (2) failed to remove a reference under 37 C.F.R. § 1.131 (as elected by Appellants), asserting confusingly that Appellants should instead initiate an interference when it is the Examiner that believes an interference should be provoked; (3) required under 35 U.S.C. § 112 that Appellants import definitions unnecessarily from the present specification into the instant claims; (4) ignored Appellants' request for evidence associated with prior traversals of the Examiner's apparent Official Notice; and (5) asserted surprisingly (in rejecting the present claims under 35 U.S.C. § 102(b)) that any two positions along a loop reactor are symmetrical.

Claim Rejections under Doctrine of Obviousness-Type Double Patenting

Although Appellants do not agree with the Examiner's double-patenting rejections, Appellants will consider filing a terminal disclaimer if necessary when the present claims are indicated as allowable. However, the Examiner inappropriately formulated both (1) a double-patenting rejection based on Hottovy, U.S. Patent No. 6,239,235 and (2) a rejection under 35 U.S.C. § 102(b) based on the same Hottovy, U.S. Patent No. 6,239,235. *See* Final Office Action, pages 2-4. Such a combination of rejections is improper. *See, e.g.,* M.P.E.P. § 804 II.B.1, p. 800-22, first column (August, 2001 and Rev. 2, May 2004). For this reason alone, *the final status of the current prosecution is inappropriate* and should be withdrawn.

Claim Rejections under 35 U.S.C. § 112, First Paragraph

The Examiner rejected claims 5 and 8 under 35 U.S.C. § 112 for failing to comply with the enablement requirement. Final Office Action, page 2. However, as discussed below, undue experimentation is *not* required by one of ordinary skill in the art to practice the subject matter recited in claims 5 and 8. *See, e.g., U.S. v. Telectronics, Inc.*, 857 F.2d at 778.

The Examiner contended that claims 5 and 8 are not enabled because “the base of the percentage of the monomer is not defined.” *See* Final Office Action, page 2. However, the base of the percentage of monomer (e.g., ethylene) is defined. *See, e.g.,* Specification, Examples I and II, pages 11 and 12, ¶¶ 36 and 27 (explaining that to calculate the percent ethylene, the “pounds of ethylene” in the reactor are divided by the “pounds of the liquid contents in the reactor”). Clearly, the monomer concentration is expressed as a weight percent of the liquid contents in the reactor. The Examiner acknowledged this definition but argued that “such [a] limitation must be inserted into the claims in order to overcome the rejection.” To the contrary, this definition need not be inserted into the claims. In view of the specification and what is known in the art, one of ordinary skill in the art would straightforwardly understand the subject matter of claims 5 and 8. *See, e.g., Phillips v. AWH Corp.*, No. 03-1269, -1286, at 13-16 (Fed. Cir. July 12, 2005);

The Examiner asserted that claim 5 must be amended to make more clear that the swing percentage presented in claim 5 refers to the difference in concentration through the loop reactor

(and not directly to the actual concentration). However, in view of the specification, Appellants respectfully assert that the claim 5 is clear to one of ordinary skill in the art, and is enabled. Claim 5 expresses the swing in monomer concentration as an absolute difference in percentage (e.g., 1.05%), a well-known methodology in the art. *See* page 2, ¶ 8. *See, e.g.,* Specification, Specification, page 6 ¶¶ 19 and 29; pages 11 and 12, ¶¶ 36 and 27. A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661 (Fed. Cir. 1991).

As explained, Appellants believe claims 5 and 8 to satisfy 35 U.S.C. § 112 and to be in condition for allowance. However, in an effort to advance prosecution Appellants would consider amendments to these claims 5 and 8.

Claim Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-4, 6, 7, 9-15, and 21-27 under U.S.C. § 102(b) as anticipated by Hottovy et al. (U.S. Patent No. 6,239,235) and rejected claims 1-15 and 21-27 are rejected under 35 U.S.C. 102 (e) as being anticipated by Kendrick et al. (US 2002/0173598 A1, now US Patent No. 6,833,415). Claims 1 and 24 are independent.

Legal Precedent

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). Every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

Deficiencies of the Rejection based on Hottovy

Independent claim 1, as amended, recites “wherein the monomer feeds are *substantially symmetrically* arranged around the loop reaction zone.” (Emphasis added). Independent claim 24 recites “wherein the monomer feeds and the product take-offs are arranged *substantially symmetrically* about the loop reactor.” (Emphasis added). In contrast, Hottovy is *absolutely devoid* of arranging monomer feeds and/or product take-offs substantially symmetrically about the loop reactor. Therefore, Hottovy cannot anticipate claims 1 and 24, or their dependent claims. In the

Final Office Action, the Examiner asserted incorrectly that two feeds (or two take-offs) would *always* be symmetrical about the loop reactor. The Examiner contended that such symmetry “C₂ symmetry,” a term generally used in the molecular arts and inapplicable to the present claims. The phrase “C₂ symmetry” is used to describe the mirror plane symmetry associated with molecules and their isomers. However, contrary to the Examiner’s assertion, two feeds, for example, will not always be symmetrical. This is so when even considering the concept of the inapplicable C₂ symmetry. The multiple dissimilar segments of the loop reactor make clear that two feeds will *not* always be symmetrical, even where rotated 180°, as with molecular mirror symmetry.

Request Removal of Kendrick

Kendrick is not valid prior art because Appellants, in a previous Response (which is herein incorporated by reference), elected to remove Kendrick et al. (US 2002/0173598 A1, now issued as US 6,833,415) under 37 C.F.R. § 1.131. *See* Response to Final Office Action Mailed February 24, 2005, pages 10-17. Again, Appellants respectfully assert that the previously-submitted Rule 131 Declaration and the accompanying exhibits sufficiently establish an earlier date of the invention of the subject matter disclosed and claimed in the present application. *See* Rule 131 Declaration of Donald W. Verser; Exhibits C, D, and E. These documents establish conception prior to the effective dates of the cited reference and, furthermore, establish diligence during the critical period from just prior to the effective date of the cited reference until constructive reduction to practice of the present application. *See* 37 C.F.R. § 1.131(b); M.P.E.P. §715.07(III). Therefore, Appellants believe that the cited reference should be removed.

Appellants Decline to Provoke an Interference with Kendrick et al. (US 6,833,415)

With regard to Kendrick et al. (US 6,833,415), Appellants believe the appropriate path is to removed the Kendrick et al. (US 6,833,415) via the previously-submitted Rule 131 Declaration, as discussed above. If the Examiner disagrees with Appellants and believes that “the reference is claiming the same patentable invention,” and therefore, the previously-submitted “declaration of June 27, 2005 is inappropriate under 37 CFR 1.131(a),” it is the Examiner’s responsibility to initiate the interference, not Appellants. *See* M.P.E.P. Chapters 800

and 2300; Final Office Action, pages 4-5. The Examiner must either remove the reference under 37 C.F.R. § 1.131 or provoke an interference. *See* M.P.E.P. § 2306.

Request Evidence to Support Official Notice

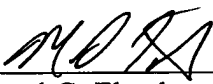
Further, features recited in the dependent claims, such as the separate control of monomer feeds, unimodal production, etc., are *not* within the generic disclosure of the prior art, as incorrectly asserted by the Examiner. *See* Final Office Action, page 3-4. Indeed, Appellants believe these features unique and not found in the prior art. Conversely, the Examiner asserted that such features are known and understood in the art. Therefore, the Examiner has essentially taken Official Notice of facts outside of the record that the Examiner apparently believes are capable of demonstration as being “well-known” in the art. *See id.* Appellants emphasize that the features are *not* of a “notorious character” and are clearly not “capable of such instant and unquestionable demonstration as to defy dispute.” *See* M.P.E.P. § 2144.03. Therefore, in accordance with M.P.E.P. § 2144.03, Appellants have seasonably traversed and challenged the Examiner’s use of Official Notice. Appellants have requested that the Examiner produce evidence in support of the Examiner’s position. The Examiner failed to do so.

Request Withdrawal and Review of Final Rejections

In view of the foregoing, Appellants respectfully request that the Examiner withdraw the rejection of claims 1-21 and allow the pending claims 1-21. Further, Appellants respectfully request review of the Final Rejections prior to filing of an Appeal Brief in the present application.

Respectfully submitted,

Date: May 22, 2006



Michael G. Fletcher
Reg. No. 32,777
FLETCHER YODER
P.O. Box 692289
Houston, TX 77269-2289
(281) 970-4545